

## **REMARKS**

Claims 1-11 and 13-28 were pending in this matter at the time of the Office action. As a result of this amendment, claims 1, 21, 25, 27 and 28 have been amended, claim 29 has been added and claim 20 has been canceled. No new matter has been added. The response below is made in view of the amended claims.

### **Allowable Subject Matter**

The Applicant gratefully acknowledges the Examiner's determination that claim 26 is allowed and that claims 16, 20, 21, and 24 contain allowable subject matter and would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

### **Claim Rejections -- 35 USC §102 and §103**

The Examiner has rejected claims 1-3, 5, 17-19, and 25 under 35 USC §102(b) as being anticipated and claims 9-11 under 35 USC §103(a) as being unpatentable over Miller (GB 2,223,023). Applicant respectfully traverse the foregoing rejections in view of the above pending claims and for reasons set forth hereafter.

The Examiner has indicated that Miller '023 provides a composition of matter comprised of SIS block copolymer, hydrocarbon resin and aromatic and/or chlorinated hydrocarbon solvent, wherein trichloroethylene is the chlorinated solvent. Without opining as to the merits of the Examiner's assertion, independent claim 1 has been amended to recite that the hydrocarbon resin used in the composition is an aromatically modified C5 hydrocarbon resin. As stated by the Examiner in this Office action, the use of an aromatically modified hydrocarbon resin is an unobvious features of the instant invention. Thus, it is respectfully submitted that it is clear that Miller '023 does not teach or suggest the invention of independent claim 1. In particular, Miller '023 does not teach or suggest a composition utilizing an aromatically modified C5 hydrocarbon resin in conjunction with a rubber composition and a non-flammable solvent. Independent claim 25 has been amended to recite that the block copolymer is a styrene-butadiene-styrene block copolymer and that the non-flammable chlorinated organic solvent is ethylene tetrachloride. It is respectfully submitted that it is clear that Miller '023 does not teach or suggest the invention of

independent claim 25. In particular, Miller '023 does not teach or suggest a composition utilizing a styrene-butadiene-styrene block copolymer and a non-flammable chlorinated organic solvent of ethylene tetrachloride. Thus, the amendments to claims 1 and 25 should distinguish over Miller '023 and are now believed to be an allowable condition. Also, since dependent claims 2, 3, 5, 9-11 and 17-19 depend directly from claim 1, it is respectfully submitted that these dependent claims also define allowable subject matter as well.

The Examiner has rejected claims 1-5, 7, 17-19, 22, 23, and 25 under 35 USC §102(b) as being anticipated and claims 9-11, 27, and 28 under 35 USC §103(a) as being unpatentable over Gaveske (6,025,032). Applicant respectfully traverse the foregoing rejections in view of the above pending claims and for reasons set forth hereafter.

The Examiner indicated that Gaveske '032 provides a method and composition for waterproofing a substrate using a formulation comprised of a halogenated organic solvent such as methylene chloride, ethylene chloride, trichloroethylene and chlorobenzene, a hydrocarbon resin and a block copolymer. Independent claims 1, 27 and 28 have been amended to recite that the hydrocarbon resin used in the composition is an aromatically modified C5 hydrocarbon resin. As stated in the arguments regarding Miller '023, the use of an aromatically modified hydrocarbon resin is an unobvious features of the instant invention. Thus, it is respectfully submitted that it is clear that Gaveske '032 does not teach or suggest the invention of independent claims 1, 27 and 28. In particular, Gaveske '032 does not teach or suggest a composition utilizing an aromatically modified C5 hydrocarbon resin in conjunction with a rubber composition and a non-flammable solvent. Independent claim 25 has been amended to recite that the block copolymer is a styrene-butadiene-styrene block copolymer and that the non-flammable chlorinated organic solvent is ethylene tetrachloride. It is respectfully submitted that it is clear that Gaveske '032 does not teach or suggest the invention of independent claim 25. In particular, Gaveske '032 does not teach or suggest a composition utilizing a styrene-butadiene-styrene block copolymer and a non-flammable chlorinated organic solvent of ethylene tetrachloride. Thus, the amendments to independent claims 1, 25, 27 and 28 should distinguish over Gaveske '032 and are now believed to be an allowable condition. Also, since dependent claims 2-5, 7, 9-11, 17-19, 22, and 23 depend directly from claim 1, it is respectfully submitted that these dependent claims also define allowable subject matter as well.

The Examiner has rejected claims 1, 3-6, 8, 13, and 17 under 35 USC §102(b) as being anticipated and claims 9-11 under 35 USC §103(a) as being unpatentable over Lehman (4,970,242). Applicant respectfully traverses the foregoing rejections in view of the above pending claims and for reasons set forth hereafter.

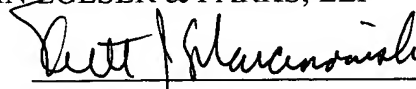
The Examiner indicated that Lehman '242 discloses a non-flammable composition comprising a solvent, butadiene-styrene rubber, a tackifying resin and a stabilizing agent. Independent claim 1 has been amended to recite that the hydrocarbon resin used in the composition is an aromatically modified C5 hydrocarbon resin. As stated in the arguments regarding Miller '023 and Gaveske '032, the use of an aromatically modified hydrocarbon resin is an unobvious feature of the instant invention. Thus, it is respectfully submitted that it is clear that Lehman '242 does not teach or suggest the invention of independent claim 1. In particular, Lehman does not teach or suggest a composition utilizing an aromatically modified C5 hydrocarbon resin in conjunction with a rubber composition and a non-flammable solvent. Thus, the amendment to independent claim 1 should distinguish over Lehman '242 and is now believed to be an allowable condition. Also, since dependent claims 3-6, 8 and 17 depend directly from claim 1, it is respectfully submitted that these dependent claims also define allowable subject matter as well.

In view of the above, Applicant respectfully submits that claims 1-11, 13-19 and 21-29 are in condition for allowance. Prompt consideration of this application and allowance of these claims are requested. If the Examiner should have any questions regarding this application or the amendment, a call to Applicant's attorney would be appreciated.

Respectfully submitted,

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